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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,174	03/31/2004	Minoru Kawahara	SON-2966	4459

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EXAMINER

GUPTA, PARUL H

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,174

Applicant(s)

KAWAHARA, MINORU

Examiner

Parul Gupta

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-9 are pending for examination as interpreted by the examiner. The IDS filed on 6/23/05 and 9/26/06 were considered. The preliminary amendment filed on 6/23/05 has been approved to be entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 is drawn to a “**program**” *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical

"things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Sako et al., US Patent Publication 2003/0161233.

Regarding claims 1 and 6-9, Sako et al. discloses in figure 10 a recording device, method, and a recording medium on which a program readable by a computer to make the computer execute a process is recorded for recording first encoded data at a high bit rate and second encoded data at a lower bit rate than that of said first encoded data, both encoded data corresponding to the same material data, on an information recording medium. Paragraph 0013 explains that different formats of data are used. The different formats are given in paragraphs 0029 and 0030 to consist of different recording densities. Thus, a different bit rate is necessary to encode both formats together as given in the invention of the reference. Sako discloses the recording device, method, and a recording medium comprising: first generation means (element 12 of figure 10 as

explained in paragraph 0054) for encoding said material data input thereto so as to generate said first encoded data; second generation means (element 14 of figure 10 as explained in paragraph 0055) for encoding said material data input thereto so as to generate said second encoded data; recording means (elements 16-22 of figure 10) for recording said first encoded data generated by said first generation means and said second encoded data generated by said second generation means on said information recording medium in an alternate manner in terms of time (the switching unit of element 15 of figure 10 performs the function of alternating data to be recorded as explained in paragraph 0056); and readout means (element 31 of figure 11) for reading out said second encoded data recorded on said information recording medium while said recording means is recording any one of said first and second encoded data (paragraph 0012), , further comprising reproducing means (element 30 of figure 11) for decoding (function performed by elements 35 and 36 of figure 11) and playing back said second encoded data read out by said readout means (element 31 of figure 11 as explained in paragraph 0062).

Regarding claim 5, Sako et al. discloses the recording device according to claim 1, wherein said recording means performs recording on said information recording medium in a CLV (Constant Linear Velocity) method (paragraphs 0062, 0065, and 0072 all give constant linear velocity as an example of the method).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sako et al. in view of Nozaki, US Patent 6,937,549.

Regarding claim 2, Sako et al. teaches the recording device according to claim 1, further comprising: storage means for storing said second encoded data recorded on said information recording medium by said recording means (shown in figure 5 and explained in paragraph 0038). Sako et al. does not but Nozaki teaches comparison means for comparing said second encoded means read out by said readout means with said stored second encoded data (column 11, lines 39-48 explain how the disc ID is compared and data is read out, which serves the same purpose). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the concept of the comparison means as taught by Nozaki into the system of Sako et al. The motivation would be to ensure quality of data before finalizing the disc (column 11, lines 29-38).

Regarding claims 3 and 4, Sako et al. teaches the limitations of claim 2. Sako et al. does not but Nozaki teaches the recording device, wherein said recording means rewrites said encoded data (column 11, lines 8-14) stored by said storage means (in non-volatile memory) on said information recording medium in accordance with a result of comparison by said comparison means (which determines whether or not to finalize the disc) in a separate unrecorded area (lead-in area) on said information recording medium if a plurality of successive results of comparison by said comparison means

show that said data are not identical. The decision to write the data is based on whether or not the disc is finalized, which depends on the result of the comparison. Thus, both inventions serve the same purpose. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the concept of the comparison means as taught by Nozaki into the system of Sako et al. The motivation would be to ensure quality of data before finalizing the disc (column 11, lines 29-38).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Parul Gupta whose telephone number is 571-272-5260. The examiner can normally be reached on Monday through Thursday, from 9:30 AM to 7 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PHG
10/30/06


ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER